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EXAMINER
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MARMOR II, CHARLES ALAN

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



### **DETAILED ACTION**

1. This Office Action is responsive to the Request for Reconsideration filed October 13, 2005. The Examiner acknowledges Applicant's Remarks. Claims 1-24 are pending.

#### ***Response to Amendment***

2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 8, 12, 13 and 17-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Merry et al. ('235). Merry et al. disclose an adaptor comprising a manifold (11) having a port (adjacent reference character 14) that is capable of being used as a suction port and ports (12,13) capable of receiving other medical devices. A flexible flow valve (26) is positioned in both a first flow path between a first device port (13) and a second device port (12) and a second flow path between the first device port (13) and the suction port (adjacent reference character 14). The suction port is configured such that it is capable of connecting to a suction source. A first device port (13) is configured such that it is capable of accommodating an endoscope. The

flexible flow valve (26) is a substantially flat membrane with three flaps and an opening (see Figure 4) that is configured to increase due to fluid flow therethrough, a difference in pressure at proximal and distal sides of the valve, or due to an application of suction. The first device port may be considered to be adjacent the Luer connector (13) which may be considered a third device port (See Figures 1-3) that is configured such that it is capable of connecting to another medical device. A second flexible flow valve (29) includes an opening and is located between the third device port (13) and both the second device port (12) and the suction port (adjacent reference character 14).

Regarding claims 17-20, it has been held that "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5-7, 9-11 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merry et al. ('235). Merry et al, as applied to claim 1 above, teach the invention as recited for claim 1 but do not disclose detailed features of the valve. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the claimed valve features for the purpose of directing flow, since it was known in the art that any common valve in various positions would direct the flow as desired.

### *Response to Arguments*

7. Applicants' arguments, see pages 2-5 of the Request for Reconsideration filed October 13, 2005, with respect to the rejections of claims 1-3, 12, 13 and 17-22 under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 5,356,375 to Higley and of claims 4-11 and 14-16 under 35 U.S.C. 103(a) as being unpatentable over Higley have considered but are moot in view of the new grounds of rejection. Applicants contend that Higley fail to disclose or suggest at least "a flexible flow valve having an opening positioned in both a first flow path between the first device port and the second device port and a second flow path between the first device port and the suction port" because the exhaust check valve 22 is not in "a first flow path between the first device port and the second device port when reference character 25 is considered to be the suction port. These arguments are moot in view of the new grounds of rejection set forth hereinabove citing Merry et al. With regard to the rejections of claims 4-11 and 14-20, Applicants further state that Applicants do not necessarily agree with comments regarding the nature of dependent claims 17-20 or the section 103 rejection of dependent claims 4-11 and 14-16 set forth in the most recent Office Action and decline to subscribe to any statement or

characterization in the Office Action. Since Applicants fail to set forth any specific reasons why these characterizations and rejections are improper, similar rejections citing Merry et al. have been set forth in this Office Action.

### ***Conclusion***

8. Applicant's amendment of April 25, 2005 necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Marmor, II whose telephone number is (571) 272-4730. The examiner can normally be reached on M-TH (7:00-5:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles A. Marmor, II  
Primary Examiner  
Art Unit 3736

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December 12, 2005